

Remarks

Claims 6-23 are pending. No new matter is added.

Rejection under 35 U.S.C. §101

According to MPEP 2106 (IV)(D), "The examiner bears the initial burden ... of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24USPP2d 1442, 1444, (Fed. Cir. 1992). Applicants submit that the Examiner has never met this initial burden.

On page 2 of the Office Action mailed on 5/04/2007, "Claims 6-23 are rejected under 35 U.S.C. §101 because the claimed invention is directed toward non-statutory subject matter." The Present Office Action states:

It appears claim 6 would reasonably be interpreted by one of ordinary skill in the art as a system of software per se, failing to fall within a statutory category of invention. Applicant's specification discloses the rule evaluation system comprising rules-based agent, advertising triggering, a plurality of data providers and at least one action for providing information, and in the context of the specification and claims in question, one of ordinary skill in the art would reasonably interpret the rules evaluation system as software application. As such, the system of software alone is not a machine, and it is clearly not a process, manufacturer nor composition of matter (emphasis added).

Applicants submit that the present analysis fails to meet the initial burden of presenting a *prima facie* case of unpatentability. In response, Applicants respectfully submit that per MPEP 2106.01 and per the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Annex IV: Computer Related Non-Statutory Subject Matter), Claim 6 is drawn toward patentable matter.

As such, Applicants respectfully submit that Claim 6 is statutory, is functional, is not an abstract idea, and does produce a tangible and concrete result, and therefore overcomes the rejection under 35 U.S.C. §101. Further, Applicants submit that Claims 7-23 which depend from Claim 6 are also patentable and overcome the rejection under 35 U.S.C. §101 by virtue of their dependence upon allowable base claims.

Claim Rejections - 35 U.S.C. §103(a)

Claims 6-15, 18 and 20-22

In the present Office Action, Claims 6-15, 18 and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greer et al. (2001/0011226) hereinafter “Greer” in view of Gross et al. (5,283,856) hereinafter “Gross” and further in view of O’Toole, Jr. et al. (6,279,112) hereinafter “O’Toole”. Applicants have reviewed the above cited references and respectfully submit that the features as recited in Claims 6-15, 18 and 20-22 are patentable over Greer, either taken alone or in combination with Gross and O’Toole.

Regarding Claim 6, Applicants respectfully submit that independent Claim 6 includes the features: “a rules-based agent operating on said user computer and having a plurality of rules clauses for evaluating data, wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses.”

**To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).**

On page 4, the present Office Action states that Greer discloses “[a] rules-based agent operating on said user computer [i.e., the agent runs on the target computer CPU][321, Figure 3; and paragraphs 0017 and 0019.”

Applicants respectfully disagree with the assertion. Specifically, Applicants submit that Greer describes a baseline profile stored on a content provider. Moreover, the agent as taught by Greer is used to provide information about the target computer to the content server provider where the baseline profile is created and stored [Figure 3 step 304; and para 0017 lines1-7] (emphasis added).

For this reason, Applicants respectfully submit that the feature of a rules-based agent operating on said user computer and having a plurality of rules clauses for evaluating data, wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses; is not taught or rendered obvious by Greer (emphasis added).

Moreover, “*If the proposed **modification or combination** of the prior art **would change the principle of operation** of the prior art invention being modified, then **the***

*teachings* of the reference *are not sufficient* to render the claims prima facie obvious.”  
*In re Ratti* 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (emphasis added).

As stated herein, Applicants do not understand Greer to teach or render obvious a rules-based agent operating on said user computer and having a plurality of rules clauses for evaluating data, wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses as recited in independent Claim 6. As such, the modification of Greer in view of either Gross or O’Toole, to move the baseline profile from the content provider to the user computer as suggested in the present Office Action; would change the method of operation of Greer. In other words, Applicants understand Greer to teach *directly away* from the claimed feature.

For this reason, Applicants respectfully submit that the Combination of Greer in view of Gross and further in view of O’Toole does not establish a prima facie case of obviousness under 35 U.S.C. §103(a) as all of the features are not taught by the combination and furthermore, that the relied upon combination would change the principle of operation of the invention being modified.

Therefore, since Greer, Gross and O’Toole (whether taken separately or in combination), fail to teach or render obvious the features as recited in Independent Claim 6, Applicants respectfully submit that Independent Claim 6 overcomes the rejection under 35 U.S.C. §103(a), and is thus in condition for allowance.

In addition to being dependent upon Independent Claim 6 that has been demonstrated to be allowable over Greer, either taken alone or in combination with Gross and O’Toole, Applicants respectfully assert that dependent Claims 7-15, 18 and 20-22 provide additional patentably distinct elements that are not obvious in light of Greer, Gross and O’Toole (whether taken separately or in combination). Thus, Applicants respectfully submit that Claims 7-15, 18 and 20-22 also overcome the rejection under 35 U.S.C. §103(a), and that Claims 7-15, 18 and 20-22 are in a condition for allowance.

#### Claims 17-19

In the present Office Action, Claims 17-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greer in view of Gross further in view of O’Toole, Jr. and Binder (6513052). Applicants have reviewed the above cited references and respectfully

submit that the features as recited in Claims 17-19 are patentable over Greer, either taken alone or in combination with Gross and O'Toole and Binder.

With respect to Claims 17-19, Applicants respectfully state that Claims 17-19 depend from the allowable Independent Claim 6 and recite further features of the present claimed invention.

#### Claim 23

In the present Office Action, Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Greer in view of Gross further in view of O'Toole, Jr. and Klayh. Applicants have reviewed the above cited references and respectfully submit that the features as recited in Claim 23 is patentable over Greer, either taken alone or in combination with Gross and O'Toole and Klayh.

With respect to Claim 23, Applicants respectfully state that Claim 23 depends from the allowable Independent Claim 6 and recites further features of the present claimed invention.

#### Claim 16

In the present Office Action, Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Greer in view of Gross further in view of O'Toole, Jr. and Dentel et al. (7062451) hereinafter "Dentel". Applicants have reviewed the above cited references and respectfully submit that the features as recited in Claim 16 is patentable over Greer, either taken alone or in combination with Gross and O'Toole and Dentel.

#### **According to MPEP 706.02(I)(1)**

**\*>Enacted on< November 29, 1999, >the American Inventors Protection Act (AIPA) added< subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) \*\*>as< disqualified \* prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." \*>The 1999< change to 35 U.S.C. 103(c) \*>only applied< to all utility, design and plant patent applications filed on or after November 29, 1999\*\*>.**

Applicant respectfully submits that the Present Application 09/922,709 and US Patent 7,062,451 (Dentel) were, at the time the invention of Application 09/922,709 was made, commonly owned by or subject to an obligation of assignment to Hewlett-Packard Company. Moreover, Dentel filed on 7/31/2000 would be prior art under former 35

U.S.C. 103 via 35 U.S.C. §102(e) based on the priority of the present Application to provisional patent Application serial number 60/263089 filed on 1/19/2001.

Thus, Applicants respectfully submits that Dentel is disqualified as prior art. Thus, the rejection of Claim 16 under 35 U.S.C. §103(a) with regard to Dentel is moot.

Therefore, Applicants respectfully submit that the shortcomings of Greer, either taken alone or in combination with Gross and O'Toole as stated on page 10 of the present Office Action with regard to Claim 16 clearly provides the allowability of Claim 16.

### CONCLUSION

In light of the above amendments and remarks, Applicants respectfully request allowance of Claims 6-23.


The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present application.

Applicants believe that no fees are currently due, however, should any fee be deemed necessary in connection with this Amendment and Response, the Commissioner is authorized to charge deposit account 08-2025, referencing the Attorney docket number 200400111-1.

Respectfully submitted,

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